RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2881

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Radislav Alexandrovich POTYRAILO Group: 2881

Application No.: 09/854,718 Examiner: David A. VANORE

Filed: May 14, 2001

For: METHOD FOR THE RAPID DETERMINATION OF THE OPTICAL QUALILTY OF COMBINATORIAL LIBRARIES

MPEP 706.07(c) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL REJECTION

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Sir:

The Supervisory Primary Examiner is requested to withdraw the May 19, 2004 Final Rejection in this case for the following reasons:

1. Claims 1 to 11, 13 to 20, 22 to 27, 29 to 32 and 46 to 59 are pending.

2, A June 2, 2004 Final Rejection rejected claims 1 to 11, 13 to 20, 22 to 32 and 46 to 59 under 35 U.S.C. §102(a) over Nielsen, U.S. Pat.5,151,123.

3. The June 2, 2004 Final Rejection is a premature final rejection.

I. THE FINAL REJECTION FAILS TO EXAMINE THE CLAIMS

4. 37 C.F.R. § 1.104 entitled "Nature of examination" provides that

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter *of the claimed invention*. (Emphasis added.)

5. The pending independent claims are:

1. A system for the optical interrogation of combinatorial arrays (12), comprising:

a testing device (108);

a combinatorial array (12) having a surface (14) with a plurality of predefined regions, the plurality of predefined regions comprising one or more test result samples and reference regions resulting from testing in the testing device (108);

a radiation source (16) operable, to expose each of the plurality of predefined regions of the combinatorial array (12) to incident radiation (20) of at least one selected wavelength and intensity;

a detector (26) operable to measure resultant radiation (22) for each of the plurality of predefined regions of the combinatorial array (12); and

a computer to functionally control the operation of the system and determine the relative performance of each of the plurality of predefined regions of the combinatorial array (12).

19. A method for ~~the~~ optical interrogation, comprising the steps of:

providing a coated substrate;

applying tests onto the coated substrate to form an array of combinatorial test result regions;

exposing the array of test result regions to incident radiation (20) of at least one selected wavelength and intensity;

collecting resultant radiation (22) for the regions of the combinatorial array (12); and

determining performance of result regions according to respective resultant radiation.

46. A method of testing and interrogating the results of the testing, comprising:

applying varying testing conditions across a substrate to form a

pattern of test results;

exposing the pattern of test results to incident irradiation;

detecting radiation scattered from the pattern of test results; and

referencing detected scattered radiation to a position of a corresponding test result in the pattern to determine a varied testing condition that resulted in the scattered radiation.

6. The Final Rejection identifies a perceived "gist" of the invention, which it has examined; to wit, the Final Rejection has identified the invention as a "solvent exposure test," (page 2, line 8, an "interrogative procedure to test materials and polymers," (page 2, lines 10 to 11), "solvent exposure device and method," (page 2, line 12), "effect of polymer plasticization by the added solvents," (page 2, lines 15 to 16),

7. However the Final Rejection fails to examine the invention as claimed in the claims, for example. the Final Rejection does not address a system for the optical interrogation of combinatorial arrays (12), comprising...a device selected form an "abrasion testing device, an elongation testing device, solvent exposure testing device, exposure to fluid testing device and a hydrolytic testing device to apply a varying test onto a combinatorial array (12) to produce a combinatorial array of varying test results" (claim 1); the Final Rejection does not address a method comprising "exposing [an] array of test result regions to incident radiation... and determining performance of result regions according to respective resultant radiation (claim 19); and the Final Rejection does not address a method comprising "applying tests onto [a] coated substrate to form an array of combinatorial test result regions" and " determining performance of result regions according to respective resultant radiation" (claim 46).

8, Further, the Final Rejection fails to examine the recited limitations of dependent claims 5 to 6, 10 and 26 to 27 and 49 to 50 and still further, the Final Rejection fails to examine the recited claim limitations of independent claim 46 and depending claims 47 to 59.

9 The Final Rejection has identified a "gist" it perceives as the invention and has examined the "gist," to wit, the invention characterizations set out in paragraph 6 above, but the Final Rejection does not examine the claimed invention.

10. The Final Rejection should b withdrawn for the PTO to address the invention as claimed in the claims in accordance with 37 C.F.R. § 1.104.

II. THE FINAL REJECTION FAIRLS TO POINT OUT WHERE PURPORTED TEACHINGS APPEAR IN THE REFERENCES

11. 37 CFR 1.104 entitled "Nature of examination" provides that

> In rejecting claims for want of novelty or for obviousness.... the particular part [of a reference] relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 CFR 1.104 (c) (2).

12. May 3, 2004 Amendment pointed out that Nielsen does not teach or suggest the claimed invention and requested the PTO to point out the teachings or suggestions of the invention in the Nielsen reference in accord with 37 CFR 1.104.

13. Apparently in response, the Final Rejection states:

> Contrary to the applicant's assertion and in order to answer the request by the applicant to point out the language in Nielsen which indicates a solvent exposure test, the examiner draws attention firstly to column 8, lines 26-40 which clearly indicates that the device and methodology taught in Nielsen are directed towards an interrogative procedure to test materials and polymers.

Final Rejection page 2, lines 7 to 11.

14. In its entirety, Nielsen column 8, lines 26 to 40 states:

> This invention provides a method for rapidly characterizing or screening arrays of multiple materials or polymers for physical and chemical properties, wherein samples of the materials or polymers have been created at known locations on a substrate surface. The materials or polymers can be combined with at least one environment-sensitive dye or optical probe, and the optical properties of the dye or optical probe are observed under conditions that allow the parallel or sequential measurement of the absolute or relative properties of the materials or polymers in the array. This invention enables the parallel or rapid sequential screening (i.e., optical measurement of various physical or chemical properties) of at least 5 materials, alternatively, the screening of at least 10 materials, alternatively, the screening of at least 20 materials,

> alternatively, the screening of at least 50 materials, alternatively the screening of at least 100 materials, ...

15. Nielsen column 8, lines 26 to 40 teaches synthesizing an array of polymer products and testing for properties of the products but not the Final Rejection does not address a system for the optical interrogation of combinatorial arrays (12), comprising...a device selected form an "abrasion testing device, an elongation testing device, solvent exposure testing device, exposure to fluid testing device and a hydrolytic testing device to apply a varying test onto a combinatorial array (12) to produce a combinatorial array of varying test results" (claim 1); the Final Rejection does not address a method comprising "exposing [an] array of test result regions to incident radiation... and determining performance of result regions according to respective resultant radiation (claim 19); and the Final Rejection does not address a method comprising "applying tests onto [a] coated substrate to form an array of combinatorial test result regions" and " determining performance of result regions according to respective resultant radiation" (claim 46).

16. The Final Rejection continues:

> Secondly, by looking to Example 4 at column 12 of Nielsen, it is clear that the solvent exposure device and method of the applicants invention is [sic, are] taught. As pointed out in the previous Office action, solvent is added in varying quantity [sic, quantities] to an array of polymers to create a variety of samples. Lines 19-21 of column 13 teach the varying of testing conditions and the observation of the effect of polymer plasticization by the added solvents, the solvent is exposed to the polymers in varying degrees, the temperature varied across the array, the results of the exposure of the solvent on the polymers observed

Final Rejection page 2, lines 12 to 19.

:17. Nielsen Example 4 does not teach or suggest a system for the optical interrogation of combinatorial arrays (12), comprising...a device selected form an "abrasion testing device, an elongation testing device, solvent exposure testing device, exposure to fluid testing device and a hydrolytic testing device to apply a varying test onto a combinatorial array (12) to produce a combinatorial array of varying test results"

(claim 1); the Final Rejection does not address a method comprising "exposing [an] array of test result regions to incident radiation... and determining performance of result regions according to respective resultant radiation (claim 19); and the Final Rejection does not address a method comprising "applying tests onto [a] coated substrate to form an array of combinatorial test result regions" and " determining performance of result regions according to respective resultant radiation" (claim 46).

18. Further the Final Rejection fails to point out where purported teachings of recited limitations of dependent claims 5 to 6, 10, 26 to 27 and 49 to 50 appear in the reference.

19. The Final Rejection should be withdrawn for the PTO to provide identification of teachings in the reference of the recited claim limitations or withdraw the rejection.). See 37 CFR 1.104 and *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

III. THE FINAL REJECTION FAILS TO RESPOND TO APPLICANT'S ARGUMENTS

20. Applicant has argued that :

> Nielsen at column 13 discloses applying a varying plasticizer (solvent) to synthesize varying synthesized products. A test is "a procedure in which the performance of a product is measured under various conditions," McGraw-Hill Dictionary of Scientific and Technical Terms, 5th Ed., p 2006 (1994). Nielsen teaches a synthesis product; not a system that comprises "an abrasion testing device, an elongation testing device" or "hydrolytic testing device" or a method of applying 'an abrasion test, an elongation test, solvent exposure test" or "a hydrolytic test" or "applying varying abrasion test results" or a method of "abrasion testing" and "detecting a "varying abrasion test result pattern."

May 3, 2004 Amendment page 10 lines 1 to 9.

21. The Final Rejection fails to respond to this argument.

22. 37 C.F.R. § 1.104 entitled "Nature of Examination" provides that "[t]he examiner's action will be complete as to all matters...."

23. The MPEP 2271 states:

> In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any grounds or rejection relied on should be reiterated. The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal.... [T]he final rejection... *should include a rebuttal of any arguments raised in the patent owner's response.* (Emphasis added.).

24. Further, MPEP 707.07, entitled "Completeness and Clarity of Examiner's Action," provides that "[t]he examiner must address all arguments which have not already been responded to in the statement of the rejection." Further MPEP 707.07(f) entitled "Answer All Material Traversed" states "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

25 The Final Rejection should be withdrawn for the PTO to respond to Applicant's May 3, 2004 Amendment page 10 lines 1 to 9.

IV. CONCLUSION

26. This Request to Withdraw the Final Rejection is filed pursuant to MPEP 706.07(c) and MPEP 706.07(d) as prerequisite to Petition to the Commissioner of Patents.

27. For the above reasons, Applicants respectfully request the PTO to withdraw the Final Rejection and to allow the claims or issue another non final office action to address the matters raised above in I, II, III and IV..

Respectfully submitted,

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